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09/987,153	11/13/2001	Shinichi Takagi	019519-312	6439
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EXAMINER CLARK, SHEILA V				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHI TAKAGI; AKINOBU SUZUKI

Reissue Application 09/987,153
Patent 5,986,337
Technology Center 2800

Mailed: September 24, 2009

Before LYNN M. KRYZA, *Deputy Chief Trial Administrator*.

ORDER RETURNING UNDOCKETED APPEAL

This reissue application was electronically received by the Board of Patent Appeals and Interferences on September 21, 2009. A review of the reissue application revealed that it is not ready for docketing as an appeal. Accordingly, the reissue application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

REISSUE AMENDMENTS, SUPPLEMENTAL DECLARATION REQUIRED

The Amendments/documents dated *November 13, 2001; June 11, 2007 and September 08, 2008*¹ do not appear to have been accompanied by a supplemental reissue declaration. Whenever claims are amended or added, a supplemental reissue declaration is required pursuant to MPEP 1414.01. Form PTO/SB/51S, "Supplemental Declaration For Reissue Patent Application To Correct 'Errors' Statement ([see] 37 C.F.R. § 1.175(b)(1)), " may be used to prepare a supplemental reissue declaration. Form PTO/SB/51S serves to indicate that every error in the patent that was corrected in the reissue application, but was not covered by a prior reissue oath/declaration submitted in the reissue application, arose without any deceptive intention on the part of the applicant.

REJECTION OF ALL THE REISSUE CLAIMS UNDER 35 U.S.C. 251

It does not appear that the Examiner has included in an Office action the appropriate rejection of all the reissue claims under 35 U.S.C. 251, as being based upon a defective reissue declaration, and the requirement of a supplemental reissue declaration signed by the reissue applicant to overcome such rejection. *See* MPEP § 1414.01 and MPEP § 1444 for details.

APPEAL BRIEF CLAIM APPENDIX NOT IN PROPER FORMAT

A review of the Appeal Brief filed by appellant on *December 10, 2008*, reveals that the Claims Appendix of the Appeal Brief is not in proper format.

¹ Please note that the amendment received on September 08, 2008 has not been entered by the Examiner, per the Advisory Action mailed on October 9, 2008.

The copy of the claims should be in proper format and must contain markings such as brackets or underlining in accordance with 37 C.F.R. § 1.173(d). *See also Manual of Patent Examining Procedure* (MPEP) § 1454 (8th ed. Rev. 6, Sept. 2007) (“The claims on appeal presented in an appeal brief for a reissue application should include all underlining and bracketing necessary to reflect the changes made to the patent claims during the prosecution of the reissue application. In addition, any new claims added in the reissue application should be completely underlined”). Appropriate correction of all claims provided in the Claims Appendix to be in proper format pursuant to 37 C.F.R. § 1.173 is required.

CLARIFICATION OF STATUS OF ORIGINAL CLAIMS 1-10

It appears from the record that original patent claims 1-10 have not been canceled by any amendments received; however, said claims have not been either rejected, or allowed in any communication sent by the Examiner to the applicant, since the initial non-final Office action mailed on August 29, 2003, in which claims 1-15 were rejected. Clarification of the record as to the status of claims 1-10 is therefore required, i.e., does the rejection of claims 1-10 set forth on August 29, 2003 stand, or has the rejection been withdrawn/overcome and the claims 1-10 are allowable. Note that if claims 1-10 are allowable, then reasons for patentability must be provided.

CONCLUSION

Accordingly, it is

ORDERED that the application be returned to the examiner for the following:

- 1) mail a communication setting forth the appropriate rejection of all the reissue claims under 35 U.S.C. 251, as being based upon a defective reissue declaration, and the requirement of a supplemental reissue declaration signed by the reissue applicant to overcome such rejection, per MPEP 1414.01 and MPEP § 1444; and,
- 2) a communication that the appeal brief submitted on December 10, 2008, is defective and that a corrected claims appendix with the new claims underlined is required; and,
- 3) a clarification of the record specifying the status of original patent claims 1-10; and,
- 4) such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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LMK/MAT

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